UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,730	01/24/2001	Steve Buckley	YOR92000694US1	2263

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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2nd copy set

	Application No.	**Applicant(s)**
Office Action Summary	09/767,730	BUCKLEY ET AL.
	Examiner	**Art Unit**	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>4-10,12-17,20-22,25-34 and 37-45</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>4-10,12-17,20-22,25-34 and 37-45</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/19/05

has been entered.

Response to Amendment

The amendment filed 7/15/05 has been entered.

Claim Status

Claims 4-10, 12-17, 20-22, 25-34, 37-42, 43, 44, 45 are active. Claims 1-3, 11,

18-19, 23-24, 35-36 are canceled.

Claim Rejections - 35 USC § 112

2.   **Claims 43, 4-10, 12-17, 20-22 are rejected under 35 U.S.C. 112, second**

paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

In claim 43, the 4th step of "presenting a dynamic set of questions ....said

dynamic set of questions", or lines 11-16, is vague and indefinite because it's not clear

the relationship of this step with the previous 3 steps above. Applicant needs to show

an example of how this works. The 4th step itself is also vague and indefinite because

it's not clear the relationship between "such that questions ... purposes" to the previous

phrase or lines 11-13. Lines 14-16 are also vague since they are connected by fragmented phrases and it's not clear the bottom line of the 4th step above.

In claim 43, the 5th step of "using a computer to analyze a user's answer ... to said user", or lines 17-19, is vague and indefinite because it's not clear the relationship of this step with the previous 4th step above. Applicant needs to show an example of how this works. The 5th step itself is also vague and indefinite because it's not clear what the bottom line of the 5th step.

In claim 43, the 6th step of "using a computer to analyze a user's answer ... on investment analysis", or lines 20-22, is vague and indefinite because it's not clear the relationship of this step with the previous 5th above. Applicant needs to show an example of how this works. The 6th step itself is also vague and indefinite because it's not clear what the bottom line of the 6th step.

In claim 43, the 7th step of "selecting a specific industry code associated with the selected industry", or line 23, is vague and indefinite because it's not clear the relationship of this step to the previous 6th above and how this step would fulfill the scope of the claim which calls for "providing business solutions over an interactive communications medium". In fact there is no discussion or explanation with respect to "interactive communication".

3.   Claims 44, 25-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 44, the 4th element of "means for presenting a dynamic set of questions ....said dynamic set of questions", or lines 13-18, is vague and indefinite because it's not clear the relationship of this means for with the previous 3 means for above. Applicant needs to show an example of how this works. The 4th step itself is also vague and indefinite because it's not clear the relationship between "such that questions ... purposes" to the previous phrase or lines 13-15. Lines 16-18 are also vague since they are connected by fragmented phrases and it's not clear the bottom line of the 4th step above.

In claim 44, the 5th element of "means for using a computer to analyze a user's answer ...to said user", or lines 17-19, is vague and indefinite because it's not clear the relationship of this step with the previous 4th means for above. Applicant needs to show an example of how this works. The 5th element itself is also vague and indefinite because it's not clear what the bottom line of the 5th element.

In claim 44, the 6th means for "using a computer to analyze a user's answer ... on investment analysis", or lines 23-25, is vague and indefinite because it's not clear the relationship of this step with the previous 5th means above. Applicant needs to show an example of how this works. The 6th means itself is also vague and indefinite because it's not clear what the bottom line of the 6th means.

In claim 44, the 7th means for "using a computer to select a specific industry <u>code</u> associated with the selected industry", or lines 26-27 is vague and indefinite because it's not clear the relationship of this means to the previous 6th means above and how this element would fulfill the scope of the claim which calls for "providing business

solutions over an <u>interactive</u> communications medium". In fact there is no discussion or explanation with respect to "interactive communication".

4.   Claims <u>45</u>, 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim <u>45</u>, the 4th step of "instructing a computer to present a dynamic set of questions ....said dynamic set of questions", or lines 13-15, is vague and indefinite because it's not clear the relationship of this step with the previous 3 steps above. Applicant needs to show an example of how this works. The 4th step itself is also vague and indefinite because it's not clear the relationship between "such that questions ... purposes" to the previous phrase or lines 15-16. Lines 16-18 are also vague since they are connected by fragmented phrases and it's not clear the bottom line of the 4th step above.

In claim 45, the 5th step of "instructing a computer to analyze a user's answer ... solutions to said user", or lines 19-21, is vague and indefinite because it's not clear the relationship of this step with the previous 4th step above. Applicant needs to show an example of how this works. The 5th step itself is also vague and indefinite because it's not clear what the bottom line of the 5th step.

In claim 45, the 6th step of "instructing a computer to analyze a user's answer ... on investment analysis", or lines 23-25, is vague and indefinite because it's not clear the relationship of this step with the previous 5th above. Applicant needs to show an

example of how this works. The 6th step itself is also vague and indefinite because it's

not clear what the bottom line of the 6th step.

In claim 45, the 7th step of "selecting a specific industry <u>code</u> associated with the

selected industry", or lines 26-27, is vague and indefinite because it's not clear the

relationship of this step to the previous 6th above and how this step would fulfill the

scope of the claim which calls for "providing business solutions over an <u>interactive</u>

communications medium". In fact there is no discussion or explanation with respect to

"interactive communication".

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

     1.   Determining the scope and contents of the prior art.
     2.   Ascertaining the differences between the prior art and the claims at issue.
     3.   Resolving the level of ordinary skill in the pertinent art.
     4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

3.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

4.   Claims 43, 4-10, 12-17 (method[1]), 44, 25-34 (apparatus[1]), and 45, 37-42

(software product[1]) are rejected under 35 U.S.C. 103(a) as being unpatentable

over CALVER in view of SARNO.

As for Independent Method claim 43, CALVER discloses a method for

providing business solutions over an interactive communications medium, comprising

the steps of:

(a) permitting a user to select an industry from a set of industries electronically

stored in a database for which business solutions are available {see Fig. 16, 0054,

0060};

(b) permitting a user to select one (or a plurality) of business measures from a

set of business measures electronically stored in a database, wherein each business

measure is associated with a particular financial aspect of a selected industry {see Fig.

16, 15, 0054, 0056, 0057};

(c) using a computer to assist a user in performing a qualitative assessment on a

selected business measure based on benchmark relevant to a selected industry {see

Fig. 15, 16, 0138, 0139};

(d) presenting a dynamic set of questions from among questions electronically stored in a database which relate to selected business measures of a selected industry, such that questions for a user can be applied to a database contents for a plurality of purposes, one of the purposes being to permit a next question to be bases on a previous question and a previous answer, and permitting a user to answer said dynamic set of questions {see 0061, 0063, 0070, 0077};

(e) using a computer to analyze a user's answers to said dynamic set of questions and to determine general or scientific business solutions based on an analysis of said user's answers, and providing said general or specific business solutions to said users {see 0072, 0075, 0138, Figs. 15, 16}; and

(f) using a computer to analyze a specific business solution and to perform a financial analysis based on a selected industry, business measures and associated benchmarks {see Fig.16, 0055, 0057 "e.g. finance calculators", 0072, 0085, 0138-0142}.

CALVER fairly teaches the claimed invention except for an additional limitation in step (f) of wherein the financial analysis parameter is a well known parameter, return on investment (or ROI).

Note: Applicant's response/argument of 12/22/04, pages 13-14, indicated that CALVER fails to teach 2 elements, (1) one of which CALVER does not provide for questions to be generated based on answers to previous questions and (2) calculation of ROI in step (f). However, as for the (1st) element, this is fairly taught in CALVER in [0063, 0061-0062, 0070]. Therefore, the only missing element in CALVER is a well known business analysis parameter, i.e. (ROI).

In another method and apparatus for <u>business financial analysis</u>, SARNO is merely cited to teach many <u>well known</u> business <u>analysis</u> parameters or types such as Return on Investment (ROI), Cost of Ownership (COO), and Cost/Benefit analysis (C/B), Rate of Return (ROR) for well known benefits such as analyzing the impact of an investment on a business for <u>cost justification</u> {see 0112, 0116, 0121}. It would have been obvious to modify the teaching of CALVER by including well known specific business financial calculation parameter such as (ROI) or (ROR) as taught by SARNO to accurately analyze the business analysis and solution for cost justification benefit as cited above {see 0117}.

As for dep. claim 3 (part of <u>43</u>), which calls for a specific industry code which is well known in industry, this is taught in CALVER {0056, 0057, 0071 or 0072}.

As for dep. claim 4 (part of <u>1</u>), which calls for a general business solution, this is taught in CALVER {Fig. 16, 0054, 0070-0071}.

As for dep. claims 5-7 (part of <u>1</u>), which calls for the provision of general business solution based on a set of rules, type of solution and ranking of solution, these are inherently taught in CALVER {[0053-0058,or 0138-0142, Fig. 15-16} to provide a real useful, targeted solutions that take my business to the next level, or reduce my costs or grow my business or protect my businesss.

As for dep. claim 8 (part of <u>1</u>), which calls for the storing of the input information, this is inherently included in CALVER Figs. 2-5.

As for dep. claim 9 (part of 1), which calls for a specific business

critieria/measure, i.e. inventory, revenue, etc., this is shown on CALVER Fig. 15, 16,

0054, 0085 "revenue of 1.8 million", or 0138.

As for dep. claim 10 (part of 1), this is taught in CALVER [0052, 0060, 0061 or

0062].

As for dep. claims 12-14 (part of 1), which deals with types of rules for

determining next question, i.e. based on the previous answer, or duplicate of previous

answer, etc., these are inherently included in the teachings of CALVER [0060-0063,

0069-0076] in order to obtain targeted and useful information.

As for dep. claim 15 (part of 1), which deals with type of metrics, i.e, quantitative

metrics, this is inherently included in CALVER Fig. 15, 16, [0070-0071, 0138-0142].

As for dep. claim 16 (part of 1), which deals with type of answer, i.e, financial

analysis, this is shown in CALVER Fig. 15, 16, [0057, 0072, 0085, 0138-0142].

As for dep. claim 17 (part of 1), which deals with well known/conventional type

of financial analysis, i.e, ROR, ROI or ROA, this is taught in SARNO [0112, 0116, 0121].

5.   **As for Independent Apparatus[1] claim 44**, which is merely system (or means

for) to carry out the steps of Method claim 1 above, it is rejected over the means to carry

out the method/steps of claim 1 above as taught by CALVER / SARNO above

(substituting "means for" for "step of").

As for dep. claims 25-27 (part of 44), which have similar limitations as in dep. claims 4-5, 8 respectively above, they are rejected for the same reasons set forth in claims 4-5, 8 above.

As for dep. claim 28 (part of 44), which has similar limitation as in dep. claim 16 above, it's rejected for the same reason set forth in claim 16.

As for dep. claim 29 (part of 44), which has similar limitations as in dep. claims 2 &15 above, it's rejected for the same reason set forth in claims 2 and 15 above.

As for dep. claims 30-31 (part of 44), which have similar limitations as in dep. claims 5, 22 above, they are rejected for the same reason set forth in claims 5, 22 above.

As for dep. claim 32 (part of 44), which have similar limitations as in dep. claims 12-13 above, it's rejected for the same reason set forth in claims 12-13 above.

As for dep. claim 33 (part of 44), which has the same limitation as in dep. claim 15 above, it's rejected for the same reason set forth in claim 15.

As for dep. claim 34, this is shown in Figs 15-16.

6. As for the machine readable medium containing code for instructing a computer to provide business solutions over an interactive communications medium in claims **43, 37-42** for carrying out the method of claims 43, 4, 7, 9, 21, 16, and 22 respectively, they are rejected for the same reason set forth in claims 1, 4, 7, 9, 21, 16, and 22, respectively above.

Note that the teaching of CALVER is carried out using the Internet or web (see Fig. 16 for summary), so program modules are inherently included to carry out any steps {as discussed in "Architecture", [0119-0130]}.

7.   Claims 5-7, 12-14 (part of 43), 25-27, 32-33 (part of 44), 37-38, 40 (part of 45) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over CALVER/SARNO in view of FRIEDMAN.

The teachings of CALVER/SARNO is cited above. As for dep. claims 5-7, 12-14, 25-27, 32-33, 37-38, 40, FRIEDMAN discloses the benefits of optimization of specific problem parameters or variables and different rules based model on Figs. 2-3, col. 4, lines 10-40, col. 6, lines 45-62. It would have been obvious to modify the teachings of CALVER/SARNO by using rules based model as taught by FRIEDMAN to obtain the benefits of optimization of the specific problem parameters or variables. Note that the use of other similar or equivalent mathematical model or rules based would have been obvious as mere using other similar or equivalent model or rules to achieve similar results. Note that on Figs. 2-4, FRIEDMAN fairly teaches the concept of optimization of the desired business parameters, i.e. resource allocation, direct transportation cost, network problems, inventory, sequential policy, generic model, queuing theory, etc.

Response to Arguments

5.   Applicant's arguments, as shown on page 14, 1st paragraph, about the specific feature shown in 4th step with respect to the questions; however, this 4th step is vague and indefinite as rejected above and it's not clear the difference between the questions in the claims vs. that of CALVER.

6.   Applicant's arguments, as shown on page 14, 3rd and 4th paragraphs, about the features of CALVER, limited to use in web-based portals for small business, while the claimed invention deals with providing business solutions and a method and system of **selling and justifying** business solutions and services via a **dynamic system**" is noted; however, these limitations, "selling and justifying business solutions", are not in the claim and there are no description or explanations with respect to "dynamic system" features in the claim.

7.   As for arguments with respect to there is no basis for combining SARNO into CALVER is not persuasive because CALVER deals with providing a business solution determining a financial analysis upon the solution and SARNO also deals with business financial analysis with disclosure of well known financial analysis parameter such as ROI for cost justification and would have been obvious to combine them to provide complete analysis of the impact of an investment on a business. Applicant's comment on page 15, 1st paragraph, that SARNO fails to address the claimed system of <u>selling</u> and justifying business solutions and services via a dynamic system is not persuasive because these language are not in the claims.

8.   As for arguments with respect to there is no motivation for combining FRIEDMAN into CALVER/SARNO is not persuasive because FRIEDMAN discloses the <u>benefits</u> of <u>optimization</u> of specific problem parameters or variables and different <u>rules based model</u> on Figs. 2-3, col. 4, lines 10-40, col. 6, lines 45-62 and would have been obvious to combine it into CALVER /SARNO to obtain the cited benefit.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

      1) http://agriculture.com is cited to teach the concept of the claimed invention

including selling and justifying business solutions and services via a dynamic

system. This is cited here for applicant's awareness and minimize multiple

rejections.

      2) Article "Business Insight" is also cited to teach well known concept of using

Business Insight for providing business solution in an interactive question-and-

answer format.

      No claims are allowed.

10.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).
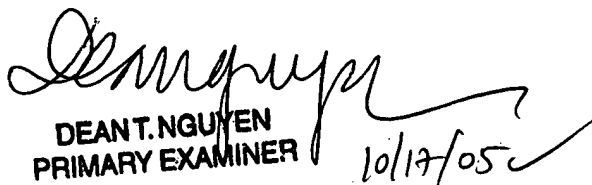
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.
The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
October 14, 2005

DEAN T. NGUYEN
PRIMARY EXAMINER   10/17/05